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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,966	08/18/2003	Paul Slovick	575.039	4160
35195	7590	03/25/2005	EXAMINER	
FERENCE & ASSOCIATES 400 BROAD STREET PITTSBURGH, PA 15143			NEWHOUSE, NATHAN JEFFREY	
		ART UNIT		PAPER NUMBER
				3727

DATE MAILED: 03/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/642,966	SLOVICK, PAUL
	Examiner	Art Unit
	Nathan J. Newhouse	3727

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
 THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 11 January 2005.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 9-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 9-12 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 9-12 rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With respect to claim 9, there is no support in the specification as originally filed for "stable support throughout at least a major portion of the interior opening in the rim". Applicant only describes the material extending far enough around in circumference to meaningfully connect with the interior opening of the rim of the tire. There is no mention that this extent is greater than a major portion of the interior opening of the rim.

With respect to claims 11-12, there is no support in the specification as originally filed for "the material to provide support and contact...of at least about 240 degrees". There is no mention of any particular angular or circumferential extent of the material, only that the important thing is that it extends far enough around in circumference to meaningfully connect with the rim of the spare tire.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claims 9-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 9, the phrase or term "stable support" is indefinite as it is unclear what comprises "stable" and how "stable" is defined as the spare tire is rotating on the rim being supported by the material.

With respect to claim 10, the phrase "extends far enough around in circumference to meaningfully connect with the interior opening in the rim" is indefinite as it is unclear exactly how far this is and is this extent a constant or does it depend upon the size of the tire, rim opening, etc. In addition, the term "meaningfully connect" is indefinite as it is unclear what this term encompasses.

With respect to claims 11-12, it is unclear how the extent of the material being 240 degrees would support or meaningfully connect with the interior opening of the rim beyond the upper half or 180 degrees of the material as below this point, the material would no longer be supporting the spare tire.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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6. Claims 9-10 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Hansen (US 4,679,717).

Hansen teaches an apparatus for carrying a spare tire comprising a tire support for mounting a spare tire including at least one lug (55) and material (56) extending past the lug which supports the rim of the tire in a manner to permit the tire to rotate and be aligned with the lug. See col. 5, lines 8-35.

With respect to claims 9-10, the material must provide "stable support throughout at least a major portion of the interior opening in the rim" as the tire is able to rotate on the material and the material provides "stable support" throughout the tire rotating 360 degrees or around a complete revolution. The material is as "circular" as applicant's invention, which is arcuate. It extends far enough around the circumference to meaningfully connect with the interior opening of the rim.

7. Claims 9-12 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by the Japanese reference (8-258755).

The Japanese reference teaches an apparatus for carrying a spare tire comprising a tire support for mounting a spare tire including at least one lug (11c) and material (11d) extending past the lug which supports the rim of the tire in a manner to permit the tire to rotate and be aligned with the lug.

With respect to claims 9-10, the material must provide "stable support throughout at least a major portion of the interior opening in the rim" as the tire is able to rotate on the material. It extends far enough around the circumference to meaningfully connect with the interior opening of the rim.

With respect to claims 11-12, the material (11d) extends in a complete circle or 360 degrees.

8. Claims 9-10 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by the Japanese reference (8-295266).

The Japanese reference teaches an apparatus for carrying a spare tire comprising a tire support for mounting a spare tire including at least one lug (22c) and material (20c) extending past the lug which supports the rim of the tire in a manner to permit the tire to rotate and be aligned with the lug.

With respect to claims 9-10, the material must provide "stable support throughout at least a major portion of the interior opening in the rim" as the tire is able to rotate on the material. The material is as "circular" as applicant's is, which is arcuate. It extends far enough around the circumference to meaningfully connect with the interior opening of the rim.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hansen (US 4,679,717).

Hansen discloses the claimed invention except for the material extending at least 240 degrees. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the material extend at least 240 degrees, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

11. Claims 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hansen (US 4,679,717).

Hansen discloses the claimed invention except for the material extending at least 240 degrees. It would have been an obvious matter of design choice to make the material extend at least 240 degrees, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Response to Arguments

12. Applicant's arguments filed January 11, 2005 have been fully considered but they are not persuasive.

Applicant argues that Hansen does not provide stable support throughout at least a major portion of the interior opening in the rim. This is incorrect. First it should be pointed out that the newly added limitations or claim language raises 35 USC 112, first and second paragraph, rejections as set forth above. In addition, as set forth above, the rejections of claims 9-12 under 35 USC 102 and/or 103, has addressed these newly added limitations. Lastly, with respect to Hansen, the material is considered to provide

"stable support" as the spare tire is able to rotate thereon to align the openings with a lug. This support is throughout at least a major portion of the interior opening in the rim as the material provides this support while letting the spare tire rotate 360 degrees or a complete revolution.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan J. Newhouse whose telephone number is (571)-272-4544. The examiner can normally be reached on Monday-Thursday, 6:00 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee W. Young can be reached on (571)-272-4549. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Nathan J. Newhouse
Primary Examiner
Art Unit 3727